

### **REMARKS/ARGUMENTS**

The listing of the claims are presented above. Applicants request clarification on Examiner's numbering of the claims under consideration. The Examiner has stated that claims 1, 3, 6, 7, 10, 11, 13-14, 16 and 33-43 are under consideration. At the time of the filing of the RCE, submitted 1/26/04, claims 1, 3, 6, 7, 10, 11, 13-14, 16, 20-21, 22-32 were pending in the application. Applicants have corrected the listing of the claims with regards to claim 20 and 21, which were withdrawn from prosecution in response to a restriction requirement in an Amendment filed Dec. 21, 1998, but never canceled. These claims are now listed as withdrawn from prosecution. New claims 33 through 43 are presented above. Therefore, Applicants consider that claims 1, 3, 6, 7, 10, 11, 13-14, 16, and 22-43 are currently under consideration.

Claims 13, 14, and 31 have been amended above to more clearly recite the subject matter considered to be the invention. Basis for the amendments is found in the specification and no new matter is added by the amendments.

The added claims 33 to 43 recite DNA, vectors, cells and polypeptides and fragments of the murine AIR, as set forth in SEQ ID NO: 5 (DNA) and 6 (polypeptide). Support for the new claims is found in the specification, and in particular in Example 8, page 25 and 26. Support for claim 42 in particular is found on page 9, which refers to native AIR including murine AIR. Inspection of SEQ ID NO: 2 and 6, which are part of the instant disclosure, indicates that SEQ ID NO: 6 has 65% homology to SEQ ID NO: 2. Therefore, the new claims presented above do not contain new matter and entry of the claims is respectfully requested.

### **Rejections under 35 U.S.C. § 112, first paragraph**

Claims 3, 7, 11, 14 and 26 are rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed. The Examiner has stated that the description in the specification of polypeptides which are "at least about 90% identical to native AIR" (page 9 of the specification) does not provide basis for the claim limitation of "at least about 98% identical" in amended claim 3 and 26 and their dependent claims. Applicants do not agree and respectfully point out that the language "at least about 98% identical" does not refer to a single member of a range but to a narrower range which is inherently contained within broader range of at least about 90%. Applicants refer the Examiner to *In re*

*Wertheim*, 541 F.2d 257, 191 USPQ 90, in which a narrower range of concentrations recited in the claim which was not explicitly recited in the specification was none-the-less determined to be in compliance with the written description requirement, on the basis that the Patent Office has failed to provide any evidence that one of skill in the art would not regard the narrower range as also being within the Applicants' invention. In the instant case, the Examiner has failed to provide any evidence that that one skilled in the art would consider that possession of a range of identities of at least 90% would not also put the inventors in possession of a narrower range of identities of at least 98%. MPEP § 2163.05 (III), referring to range limitations, states "with respect to changing numerical range limitations, the analysis must take into account which ranges one skilled in the art would consider inherently supported by the discussion in the original disclosure." Applicants respectfully submit that the limitation of "at least 90%" described in the specification inherently supports the narrower limitation of "at least 98% identity". Therefore, Applicants request that the reconsideration and withdraw the rejection of claims 3, 7, 11, 14 and 26 on the basis of 35 U.S.C. § 112, first paragraph.

Claims 31 and 32 are rejected on the basis of 35 U.S.C. § 112, first paragraph, on the basis that the claims are not enabled for "a fragment thereof". This rejection is respectfully traversed. Claim 31 has been amended to recite fragments capable of inducing apoptosis. On the basis of this amendment, Applicants respectfully request that the rejection of claims 31 and 32 on the basis of 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

Claims 13, 14, 31 and 32 are rejected on the basis of 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed. Claims 13 and 14 have been amended as shown above to recite a process of preparing the specific protein set forth in SEQ ID NO: 2 or SEQ ID NO: 6, or a protein at least 98% identical to SEQ ID NO: 2. Claim 31 now recites a fragment capable of inducing apoptosis. On the basis of these amendments, reconsideration and withdrawal of the rejection on the basis of 35 U.S.C. § 112, second paragraph, is respectfully requested.

#### **Rejections on the Basis of 35 U.S.C. § 102(e)**

Claims 3, 7, 11, 14, 22-28 and 31-32 are rejected on the basis of 35 U.S.C. § 102(e) over Yu et al, U.S. Patent 6,153,402. This rejection is respectfully traversed. The Examiner has stated that this patent discloses nucleic acids and polypeptides 90%

identical to the functional protein. Applicants point out that the priority document of U.S. Patent No: 6,153,402 on which the Examiner is relying, provisional application 60/013,285 filed March 12, 1996 describes only the DR3-VI polypeptide, which has an identity of 97.5% to SEQ ID NO: 2 of the present invention. This provisional does not disclose SEQ ID NO: 1 or 2 or any DNA or polypeptide having 98% identity to SEQ ID NO: 1 or 2. Therefore, Applicants submit that the subject matter of claims 3, 7, 11, 14, 22-28 and 31-32 is not described in this patent, and request reconsideration and withdrawal of this rejection.

Claims 1, 3, 6, 7, 10, 11, 13-14, 16 and 22-32 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent 6,462,176 and US Patent Application Publication US2002/0192729. Applicants wish to defer provoking an interference on these claims until the Examiner has considered amendments and arguments presented above on the other grounds for rejection. Applicants further wish to point out to the Examiner that new claims 33-43 recite subject matter not disclosed in either Yu et al., U.S. Patent No. 6,153,402, or in U.S. Patent 6,462,176 or US2002/0192729.

Finally, Applicants request clarification on the advisory information provided on page 5 of the Office Action of 4/01 that claims 1,6,10, 29 and 30 are allowable.

**CONCLUSION**

Entry of the amendments to the claims and the new claims is respectfully requested. On the basis of the amendments to the claims, and the arguments presented above, Applicants respectfully request reconsideration and withdrawn of the current rejections.

Applicants' attorney invites the Examiner to call her at the number below if it would be helpful in advancing the prosecution of this application.

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Respectfully submitted,



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